

REMARKS

By this amendment, claims 1-22 have been amended and claim 15 has been cancelled without prejudice or disclaimer. Claims 1-14 and 16-22 are currently pending in the application, of which claims 1, 11, 20, 21, and 22 are independent claims. The Office Action indicated that claim 20 is allowed and claim 15 is allowable if rewritten in independent form.

In view of the above amendments and the following Remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending objections and rejections for the reasons discussed below.

Allowed Subject Matter

Applicants appreciate the Examiner's indication that independent claim 20 is allowed and dependent claim 15 is allowable if rewritten in independent form. Both claims are directed to a digital camera system that prevents combining a converted image signal with a converted sound signal when the phone number of a designated remote device coincides with the phone number stored in the memory of the camera. In this response, independent claims 1, 11 and 21 have been amended to add this allowable subject matter.

Rejections Under 35 U.S.C. §103

Claims 1-7, 10-14, 18 and 19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No. 6,009,336 issued to Harris , *et al.* ("Harris") in view of U. S. Patent No. 5,719,936 issued to Hillenmayer ("Hillenmayer"), and further in view of U. S. Patent No. 6,073,034 issued to Jacobsen, et al. ("Jacobsen"). Applicants respectfully traverse this rejection for at least the following reasons.

Independent claim 1 has been amended to further recite the allowable subject matter of claims 15 and 20. Claim 1 recites:

“A digital still camera capable of telecommunication comprising:

...

a second converting unit which converts sound into an electronic signal;

...

a combination unit which combines the digital electronic signal and the electronic signal to form a combination signal;

a designating unit which designates a remote device in the wireless telephone network with a specific phone number thereof;

a storage unit which stores at least one phone number; and

a control unit which allows or prevents the combination unit from combining the digital electronic signal with the electronic signal when the specific phone number of the remote device coincides with the phone number stored in the storage unit.”

Since claims 15 and 20 are patentable over the cited references, claim 1 and its dependent claims 2-7 and 10 would be also patentable at least for the same reason.

Independent claim 11 has been amended to incorporate the allowable subject matter of claim 15, which is now cancelled. Claim 11 recites:

“A digital still camera capable of telecommunication comprising:

a converting unit which converts an optical image into a digital electromagnetic signal indicative of a still image;

a microphone which converts sound into an electronic signal;

a combination unit which combines the digital electromagnetic signal and the electronic signal to form a combination signal;

a designation unit which designates a remote device in a wireless telephone network with a specific number thereof;

*a storage unit which stores at least one phone number;
a control unit which prevents the combination unit from
combining the digital electronic signal with the electric signal
when the specific phone number of the remote device coincides
with the phone number stored in the storage unit;”*

Thus, it is submitted that claim 11 and its dependent claims 11-14, 18 and 19 are patentable over the cited references. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 8 and 9 stand rejected under 35 U.S.C. §103(a) over Harris in view of Hillenmayer and Jacobsen, and further in view of U. S. Patent No. 5,510,829 issued to Sugiyama, et al. (“Sugiyama”). This rejection is respectfully traversed.

Claims 8 and 9 are dependent from claim 1. As previously mentioned, amended independent claim 1 includes the allowable subject matter and therefore would be patentable over the cited references. Thus, claims 8 and 9 would be also patentable at least for the same reason. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 16 and 17 stand rejected under 35 U.S.C. §103(a) over Harris in view of Hillenmayer and Jacobsen, and further in view of U. S. Patent No. 5,491,507 issued to Umezawa, et al. (“Umezawa”). This rejection is respectfully traversed.

Claims 16 and 17 are dependent from claim 11. As previously mentioned, claim 11 has been amended to incorporate the limitations of allowable claim 15. Thus, claim 16 and 17 would be also patentable over the cited references. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 21 and 22 stand rejected under 35 U.S.C. §103(a) over Harris in view of Hillenmayer. This rejection is respectfully traversed. In this response, claim 21 has been amended to add the allowable subject matter of claims 15 and 20. Thus, it is submitted that claim 21 is patentable over the cited references.

As to independent claim 22, the Examiner stated that Harris discloses “a device (FIG. 1, microprocessor 137) which allows the transmission of the electromagnetic signal when the telephone number designating the remote device coincides with the specific telephone number in the memory (col. 3 line 41 - col. 4 line 60; col. 6 lines 25-49; col. 9 lines 35-65; col. 11 line 39 – col. 12 line 30)” (Office Action, Page 30).

However, none of these descriptive portions discloses allowing the transmission of the electromagnetic signal when the telephone number designating the remote device coincides with the specific telephone number in the memory.

It appears that the Examiner is relying on the system disclosed in Harris is inherently capable of this claimed feature. However, the fact that a certain result or characteristic may occur or be present in the prior art is *not sufficient* to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Rather, in order to establish inherency, the extrinsic evidence must take care that the missing descriptive matter is *necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Examiner has not established that the claimed feature of allows the transmission of the electromagnetic signal when the telephone number

designating the remote device coincides with the specific telephone number in the memory, is necessary present in Harris.

Also, inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstance is *not sufficient*. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Examiner is respectfully requested not to reject this claim for a mere possibility that the system of Harris could have been designed to perform the claimed feature.

For these reasons, it is submitted that the Examiner has not established a prima facie case of obviousness in rejecting claim 22. Thus, withdrawal of the rejection is respectfully requested.

Other Matters

In this Office Action, claims 1-14 and 16-22 have been further amended for clarification, better wording and informality correction purposes.


CONCLUSION

Applicants believe that a full and complete response has been made to the pending Office Action and respectfully submit that all of the stated objections and grounds for rejection have been overcome or rendered moot. Accordingly, Applicants respectfully submit that all pending claims are allowable and that the application is in condition for allowance.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the Applicant's undersigned representative at the number below to expedite prosecution.

Prompt and favorable consideration of this Reply is respectfully requested.

Respectfully submitted,


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